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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/865,589 05/29/01 OONO

S DAIN:312D

EXAMINER

IM52/1010
PARKHURST & WENDEL, L.L.P.
1421 PRINCE STREET, SUITE 210
ALEXANDRIA VA 22314-2805

HECKENBERG JR, D

ART UNIT

PAPER NUMBER

1722
DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/865,589

Applicant(s)

OONO ET AL.

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/429,218.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 7-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno (US 5,415,536, of record) in view of Chapman (US 5,423,669).

Ohno teaches an apparatus for forming a pattern onto an article during the injection molding thereof, comprising feed means that feeds a pattern-bearing film to a molding position (see fig. 1) where a male mold (1) and a female mold (2) are opposed, a heating board (9) that heats the pattern-bearing film so as to soften it, the heating board having a heating surface and being movable into and away from a space between the male mold and the female mold (as shown in fig. 1), transfer means that transfers the pattern-bearing film to an internal surface of the female mold so as to contact the pattern-bearing film with the internal surface (as shown in fig. 7), closing means that causes the mold and female mold thereon to approach each other to form a closed molding cavity (as shown in fig. 15), and

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a resin injection device (5) that injects a molten resin into the cavity to form a molded article to adhere the pattern-bearing film to the surface of the article. Ohno further teaches a heating wire (24) within the heating board to generate the heat, and the heating board to be arranged in a vertical direction (as shown in fig. 1).

Ohno fails to teach the heating board to be divided into a plurality of independently controlled heating blocks with temperature sensors.

Chapman teaches a film processing apparatus wherein softened film (24) is fed to male (32) and female (34) molds for shaping wherein the preheating device (38) is divided into a plurality of independently controlled heating blocks (A-D being one group, F-G being another, see col. 5, lns. 17-26) for the purpose of fine tuning the heating imparted to the heat to be processed (col. 5, lns. 20-24). Chapman further teaches a temperature sensor to be used in controlling the heat imparted to the film (see col. 4, lns. 19-30).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Ohno as such to have divided the heating board into a plurality of independently controlled heating blocks because this would have allowed for the precise control of the

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heat imparted to the film as suggested by Chapman. It further would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Ohno as such to have a temperature sensor in conjunction with the heating block because this would have allowed for further control of the heat imparted to the film as suggested by Chapman. The use of a plurality of temperature sensors would require the duplication of a known part for the purpose of the multiplied effect of more precise control over the temperature imparted to the film. Generally, the duplication of a known part for a multiplied effect has no patentable significance unless it can be shown that there is a new and unexpected result. See *In re Harza*, 124 USPQ 378 (CCPA 1960); *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11 (CA7 1977). In the instant case, as the use of a temperature is anticipated as described above, it would have been obvious to one of ordinary skill in the art that the sensor could be duplicated for the multiplied effect of more precise control over the heat imparted to the film.

5. The following reference is cited of interest:

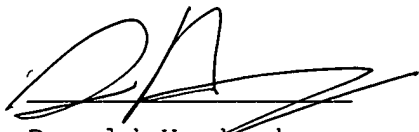
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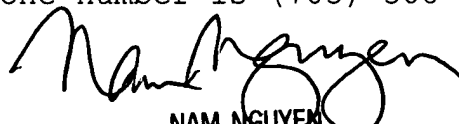
Miyazawa et al. (US 5,676,981) teaches a pattern molding apparatus wherein the heating board is comprised of a plurality of blocks.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322. The official fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718, and the unofficial fax phone number is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Donald Heckenberg
October 3, 2001


NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700